

**REMARKS**

Reconsideration of the rejections set forth in the Office action dated 10/27/2003 is respectfully requested under the provisions of 37 CFR §1.111(b). This office action reply is being mailed to the PTO on or before 1/27/2004 and thus, no extension is required. However, if such an extension is required, Applicant hereby makes the petition for the extension and authorizes the PTO to pay the fee from deposit account 24-0025.

Claims 1-16 are pending;

Claims 1-8 are elected;

Claims 9-17 are withdrawn;

Claims 1-8 stand rejected.

Claim 1 was amended.

Applicant includes a substitute specification herewith.

***I. Election of Claims***

Applicant elects claims 1-8 without traverse and has withdrawn claims 9-17.

***II. Double Patenting***

Application 09/737,869 is commonly owned with the instant application. Applicant will consider filing a terminal disclaimer for the instant application when the claims of the respective applications are determined.

***III. Claim Objections***

Claims 1-8 stand as objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter of the invention. Claim 1 has been amended per the Examiner's suggestion.

***IV. Claim Rejections under 35 USC 103(a)***

Claims 1-8 stand rejected under 35 USC 103(a) as being unpatenable over the combination of Hecht et al., (6,000,621) and Mowry, Jr (5,951,055).

The combination of the Hecht and Mowry disclosures does not teach the invention claimed in Claim 1.

The Office Action states that “this feature [a predefined occlusion area not necessary for decoding the code pattern] was exceedingly well known in the art” and asserts Mowry as an example that discloses periodic tiles comprising a predefined occlusion area not necessary for decoding a code pattern referring to Figure 7 and the accompanying discussion at col. 9 of Mowry. However, Mowry does not appear to teach periodic tiles. Further, Mowry does not teach each tile having a predefined code area having a common code pattern to the other tiles. Nor does Mowry teach a predefined occlusion area on each tile.

The Mowry reference pre-dates the Hecht reference and refers to data glyph patents dating to 1992 and 1994. None of the security documents disclosed discusses periodic tiles of data glyphs.

However, even if Mowry teaches using periodic tiles, the security document 40, 60 of Figure 7 does not in fact show, and actually teaches away from, an occlusion area on each tile. In Figure 7 Mowry shows an example of human readable transaction data as amount data 54 with encoded transaction data being positioned proximate the amount in proximate amount area 59, surrounding a physical outline 61 of the amount, as a background 63 over which the amount is printed, or printed in an interior digit space 65 of the amount (See col. 10, lines 6 – 20). Assuming for purposes of argument herein that the Office Action defines the area containing the visible amount data as an occlusion of a tile, there is simply no teaching of the same occlusion area embedded on each tile. Mowry in Figure 7 clearly shows portions of regions 56 and 57 of embedded data that have no occlusion areas.

Further, there is no teaching in Mowry (assuming Mowry teaches periodic tiles for purposes of argument) of a code pattern that is common to the other tiles.

Asserted motivation to combine the cited references

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See, e.g., *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.")

A person of ordinary skill in the art having the Hecht and Mowry references before her would not be motivated to make the combination, as asserted in the Office Action, because Mowry in fact explicitly teaches away from embedding an occlusion region on each tile when he discusses the purpose of the embedded data:

The machine readable data block is designed, i.e., shaped, sized and oriented, such that its image is distorted in the process of photocopying, or scanning, manipulating, and printing the document image.

The result is an improved security document... . If, in attempting to copy the security document of the present invention, the hidden security image is rendered ineffective... the machine readable data block is likely to be degraded and unreadable, invalidating the copy.

See col. 4, lines 59 – 66. Mowry further states:

The ability to issue documents bearing codes that describe the individual transactions extends the concept that is now used for placing the amount in words in its unique area along with the amount in specially designed numbers to make alteration more difficult. Adding the information in glyphs placed *in their own assigned area*, preferably behind the human readable numbers and words, gives an additional and sophisticated level of protection.

See col. 6, lines 42 – 49 (emphasis added).

Thus, Mowry requires that the embedded data that carries the human readable transaction data be located proximately to the human readable data such that any alteration of the human readable data renders the embedded data ineffective, which in turn alerts authorities to the altered state of the document. If the human readable data on the security document is construed to be equivalent to an occlusion, then a person of

ordinary skill would recognize that this requirement is simply inconsistent with an occlusion region embedded on each tile.

Thus, applicant respectfully traverses the 103(a) rejection of **claim 1**.

**Claims 2-8** depend on and further limit claim 1 that is patentable. Thus, claim 2-8 are patentable

In addition, with respect to **Claim 3**: First of all, the reference to figure 7 appears to be mistaken. Applicant believes the Examiner intended to reference figure 3 as all the referenced elements are present in Figure 3 and not on Figure 7. Further, the office action appears to be confused regarding code patterns. The application teaches periodic tiles that have two areas: the predefined code area having a common code pattern and the predefined occlusion area. The application also teaches placing code pattern in the occlusion area (see Fig. 5 and paragraph [0040]). Claim 3 is directed to embodiments of the invention that have a first code pattern common to each tile in the predefined code area, while having a second code pattern within an occlusion area (the second code pattern need not be the same in each occlusion area, but the occlusion area for each tile is defined as the same location(s) in each of the tiles). Thus, Mowry's security image "VOID" 70 is an image made up of security image elements and not information bearing elements. What Mowry is doing here, is using information bearing elements to serve as the complementary security image elements that are not reproducible on a copier in the same way as the security image. Thus, even assuming for purposes of discussion that Mowry teaches multiple tiles each tile having an occlusion area that can contain a second data code, the example provided in the office action does not teach having a code pattern common to the other tiles in a predefined code area, and a second code pattern in the predefined occlusion area. Claim 3 is also patentable for these reasons.

In addition, with respect to **Claims 4-5**: The office action states that Mowry discloses that the occlusion comprises a graphic (claim 4) or text (claim 5). However, as previously discussed, the predefined code area of each tile has a common code pattern, and a predefined occlusion area for each tile. Thus, assuming for purposes of discussion --- even if Mowry uses periodic tiles, and if applicant assumes that the occlusion contains

the graphic or text, it is clear from Mowry figure 7, that the occlusion areas in the tiles must be different between the tiles because the alleged occlusion areas are different shapes and shapes that cannot be assembled by using combinations of predefined tiles. Claims 4-5 are also patentable for these reasons.

In addition, with respect to **Claim 6**: The office action states that Mowry discloses multiple occlusions within the periodic tiles, but fails to disclose that there multiple occlusions within a tile. Applicant respectfully traverses the assertion that Mowry discloses multiple occlusions within the periodic tiles for the same reason as discussed in the previous paragraph. In addition, assuming multiple tiles for purposes of discussion, applicant respectfully traverses that assertion that “a tile located near the center of the document would include multiple occlusions” because each tile of the claimed invention has a predefined occlusion area. Thus, the occlusion area for each of the multiple tiles must be the same (the content of the occlusion area can be different, but the same portion of each tile is used as the occlusion area). Claim 6 is also patentable for these reasons.

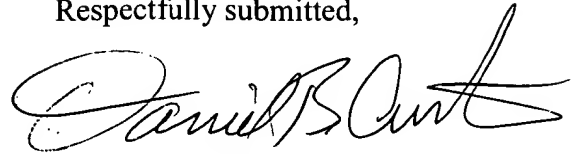
In addition, with respect to **Claims 7-8**: Again, assuming for purposes of discussion that Mowry discloses multiple tiles, there is no way to assemble multiple tiles that have the same occlusion area to create the occlusion areas on Mowry Figure 7. For example, assuming two tiles, one covering the left hand side and the other covering the right hand side of Figure 7 such that the “not valid area...” lines up, then the other asserted occlusion areas (the “void”, the “pay only” and the amount area) will not be compatible (the occlusion areas must be the same area on each tile, and these would not be). It is impossible to use multiple tiles that have the same occlusion areas to produce the asserted occlusion areas on Mowry Figure 7. Claims 7-8 are also patentable for these reasons.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

## PATENT

Should any additional issues remain, or if I can be of any additional assistance,  
please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel B. Curtis". The signature is fluid and cursive, with the first name "Daniel" being more prominent and the last name "Curtis" following in a similar style.

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